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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,625	09/19/2003	Robert H. Kummer JR.	F-724	6557
7590 Pitney Bowes Inc. Intellectual Property and Technology Law Dept. 35 Waterview Drive P.O. Box 3000 Shelton, CT 06484				
EXAMINER				
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ART UNIT		PAPER NUMBER		
3628				
MAIL DATE		DELIVERY MODE		
09/25/2008		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. KUMMER JR., JACQUES E. HASBANI
and RICHARD HORREE

Appeal 2008-4089
Application 10/665,625
Technology Center 3600

Decided: September 25, 2008

Before: WILLIAM F. PATE, III, MURRIEL E. CRAWFORD and
STEVEN D.A. McCARTHY, *Administrative Patent Judges.*

McCARTHY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

1
2 The Appellant appeals under 35 U.S.C. § 134 (2002) from the final
3 rejection of claims 1-23. We have jurisdiction under 35 U.S.C § 6(b)
4 (2002). We AFFIRM.

Postal authorities such as the U.S. Postal Service provide postage discounts for mail that is presorted based on delivery destination. (Spec. 2, ¶ 0005). To be eligible for the appropriate discounts, the mail must not only be presorted correctly based on particular delivery destination parameters, but the mail pieces must fall within certain weight and size limits. Mail rejected for failing to meet the sorting, weight or size criteria is referred to as residual mail. (Spec. 3, ¶ 0005). The claims on appeal relate to automatically correcting postage for residual mail. (Spec. 1, ¶ 0001).

ISSUES

The issue in this appeal is whether the Appellants have shown that the Examiner erred by rejecting claims 1-23 under 35 U.S.C. § 103(a) (2002) as being unpatentable over Sansone (Patent US 5,019,991, issued 28 May 1991), Uno (Patent US 5,535,127, issued 9 Jul. 1996), and Bernard (Patent US 5,717,596, issued 10 Feb. 1998). This issue turns on whether the steps of (1) generating a postage correction table from a first rate table corresponding to the first class of service used to originally process one or more pieces of residual mail and a second rate table corresponding to a second class of service to which a postage value originally applied to each of those pieces of residual mail is to be corrected and (2) deleting stored original transaction information, generating new transaction information based on the second class of service and storing the new transaction information for each of the pieces of residual mail would have been obvious in view of the teachings of Sansone, Uno and Bernard.

FINDINGS OF FACT

The record supports the following findings of fact (“FF”) by a preponderance of the evidence.

1. Sansone teaches a data processing system for automatically correcting and accounting for improperly applied postage in short paid mail. By “short paid mail,” Sansone means mail that does not have sufficient postage to cover the cost of shipping. (Sansone, col. 1, ll. 12-18).

2. Sansone’s system includes an input device which receives transactional mail data regarding factors governing the conditions of a run, such as quantity of mail, weight, present discount and amount of postage pre-printed, if any. (Sansone, col. 3, ll. 12-14 and col. 4, ll. 53-58).

3. The mail is then driven through appropriate stations for reading destination ZIP codes from the envelopes and weighing the mail. (Sansone, col. 3, ll. 15-20 and 29-32).

4. A central processing unit responds to the weight data, in accordance with a pre-stored program and postal data previously stored in a look-up table in memory, to activate a printing activating mechanism for applying appropriate postage to the envelopes. (Sansone, col. 3, ll. 59-66).

5. In the event that the postage is pre-printed, weight data from the scale is compared to the amount of pre-printed postage entered with the transactional mail data to determine if the pre-printed postage is correct. (Sansone, col. 4, ll. 8-12).

6. If the pre-printed postage is incorrect, the central processing unit calculates the correct postage and decrements the descending register accordingly. (Sansone, col. 4, ll. 12-15).

1 7. Uno discloses a mail processing apparatus. (Uno, col. 4, ll. 1-
2 3).

3 8. Uno teaches that, as of Uno's filing date, first class mail in
4 Japan was divided into standard and non-standard sizes. A rate table for
5 standard size mail consisted of two weight classes with corresponding rates.
6 A rate table for non-standard size mail consisted of eight classes with
7 corresponding rates. Uno's system stores in memory a rate table for
8 processing standard mail together with a rate table for processing non-
9 standard mail which cannot be processed as standard mail. (Uno, col. 14, l.
10 51 – col. 15, l. 56).

11 9. Bernard teaches a method for franking of pieces of mail; the
12 accounting of costs associated with mailing those pieces of mail; and the
13 billing of customers for mailing services. (Bernard, col. 2, ll. 47-49).

14 10. The amount franked for a customer, plus any service charges,
15 are posted to the customer's account. (Bernard, col. 6, ll. 17-21).

16 11. If a transaction is misapplied to a customer's account, the
17 transaction can be transferred to the correct account. (Bernard, col. 6, ll. 26-
18 39).

19 12. After the transaction is transferred from one account to another,
20 value amounts by which the balances in the first and second accounts will be
21 changed are calculated based on any charges and discounts available to each
22 of the accounts. These values then are transferred to the respective accounts.
23 (*Id.*)

PRINCIPLES OF LAW

A claim is unpatentable for obviousness under 35 U.S.C. § 103(a) if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Supreme Court set out factors to be considered in determining whether claimed subject matter would have been obvious:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Id., 383 U.S. at 17.

ANALYSIS

The Appellants argue claims 1-24 as a group. (App. Br. 10). We select claim 1 as being representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007). The Appellants contend that Sansone discloses a system which operates on a piece-by-piece basis rather than by generating a rate correction table as recited in claim 1. (App. Br. 6). The Appellants further contend that Uno fails to cure the deficiencies in the teachings of Sansone. (App. Br. 8). We disagree.

Sansone teaches originally processing one or more pieces of mail using a first rate table, that is, using postal data previously stored in a look-

up table in memory, corresponding to a first class of service. (FF 2-4). The pieces of mail so processed would bear pre-printed postage values determined in accordance with the first rate table. Sansone further teaches comparing pre-printed postage values borne by one or more pieces of mail against a second rate table corresponding to a second class of service to which the postage value originally applied to each of the one or more pieces of mail is to be corrected. (FF 2, 3 and 5). For each piece of mail for which the postage values determined using the first rate table is less than the postage value determined by the second rate table, Sansone's system determines a postage correction amount. (FF 6).

“[T]he mere application of a known technique to a piece of prior art ready for the improvement” generally will be obvious unless the application of the known technique would require more than the predictable use of the prior art elements according to their established functions. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740 (2007). Uno's would have suggested storing in memory a rate table for processing mail for delivery by a first class of service together with a rate table for processing for delivery by a second class of service mail which cannot be delivered by the first class of service. (See FF 8). It would have been obvious to one of ordinary skill in the art to have applied this suggestion to Sansone's system by storing the first rate table for use in the original processing of the mail for delivery by the first class of service and also storing the second rate table for use in processing mail which could not be delivered by the first class of service. Uno suggests that such a modification would have been within the level of ordinary skill in the art and nothing in the record suggests that such a

1 modification of the mail processing system would have produced
2 unpredictable or unexpected results.

3 Sansone teaches inputting the amount of postage pre-printed on one or
4 more pieces of mail as transactional mail data before reprocessing the mail
5 to account for improperly applied postage. (FF 2). One of ordinary skill in
6 the art would have recognized that significant data entry would be required
7 to input the amount of postage pre-printed on a large number of pieces of
8 mail. One of ordinary skill in the art also would have recognized that the
9 postage values pre-printed on mail originally processed using a first rate
10 table could be reproduced by processing mail again using the same first rate
11 table. Moreover, one of ordinary skill in the art would have recognized that
12 the steps of reading destination ZIP codes from the envelopes and weighing
13 the mail required to process mail using the first rate table would have been
14 the same reading and weighing steps necessary before comparing the pre-
15 printed postage values against a second rate table. (*Compare* FF 2, 3 and 5
16 *with* FF 2-4).

17 If, as would have been obvious, both the first and second rate tables
18 were stored in a memory of the mail processing system, it also would have
19 been obvious to one of ordinary skill in the art to reduce the amount of data
20 entry necessary to reprocess mail originally processed using the first rate
21 table to account for improperly applied postage by reading the ZIP codes
22 and weighing the mail; determining the pre-printed postage values by
23 applying the first rate table to the measured weights of the pieces of mail;
24 and determining the correct postage by applying the second rate table to the
25 measured weight. Nothing in the record suggests that such a modification of
26 the mail processing system would have been beyond the level of ordinary

1 skill in the art or that such a modification would have produced
2 unpredictable or unexpected results.

3 The mail processing system of Sansone modified in accordance with
4 the reasoning detailed in the previous two paragraphs would perform the
5 steps of accessing a first rate table corresponding to the first class of service
6 used to originally process the one or more pieces of mail; accessing a second
7 rate table corresponding to a second class of service to which a postage
8 value originally applied to each of the one or more pieces of mail is to be
9 corrected; and determining a postage correction amount to each of the one or
10 more pieces of mail. The modified system would determine the postage
11 correction amount by subtracting the pre-printed postage value obtained by
12 applying the first rate table to the measured weight from the correct postage
13 value obtained by applying the second rate table to the same measured
14 weight. One of ordinary skill in the art would have recognized that this
15 difference would equal the difference between the postage values shown in
16 the first and second rate tables corresponding to the measured weight.

17 We agree with the Examiner (Ans. 16) that it would have been
18 common knowledge in the art that such a comparison between the postage
19 values shown in the first and second rate tables for any given measured
20 weight inherently would be tabular. More specifically, it would have been
21 obvious to one of ordinary skill in the art that the calculation of the
22 difference between the correct postage value and the pre-printed postage
23 value could have been speeded up by substituting a single table containing
24 the differences of the values shown in the first and second weight tables for
25 the separate first and second weight tables for purposes of determining the
26 difference between the correct postage values and the pre-printed postage

1 values. Nothing in the record suggests that further modifying Sansone's
2 mail processing system in this manner would have been beyond the level of
3 ordinary skill in the art or that such a modification would have produced
4 unpredictable or unexpected results.

5 Hence, the combined teachings of Sansone and Uno would have
6 suggested a method of processing one or more pieces of residual mail using
7 a mail processing system including the step of generating a postage
8 correction table from the first and second rate tables.

9 The Appellants further contend that Sansone does not disclose a
10 system which deletes the stored original transaction information for each of
11 the one or more pieces of residual mail; generate new transaction
12 information for each of the one or more pieces of residual mail based on the
13 second class of service; and store the new transaction information for each
14 of the one or more pieces of residual mail. The Appellants further contend
15 that Bernard does not cure the deficiencies in the teachings of Sansone.
16 (App. Br. 7). We disagree.

17 If the subject matter of a claim "simply arranges old elements with
18 each performing the same function it had been known to perform' and yields
19 no more than one would expect from such an arrangement, the combination
20 is obvious." *KSR Int'l*, 127 S.Ct. at 1740 (quoting *Sakraida v. Ag Pro, Inc.*,
21 425 U.S. 273 (1976)). As detailed above, the combined teachings of
22 Sansone and Uno would have suggested the first five steps of the method
23 recited in claim 1. Bernard teaches that a transaction misapplied to a
24 customer's account may be transferred to the correct account. (FF 11). The
25 teachings of Bernard would have suggested further modifying the mail
26 processing system taught by Sansone to permit the posting information

1 relating to separate customers to separate customer accounts and to permit
2 the transfer of a misapplied transaction to the correct account. Nothing in
3 the record suggests that such a modification would have been beyond the
4 level of ordinary skill in the art. The transfer capability suggested by
5 Bernard would have performed the same function if added to the system
6 suggested by the teachings of Sansone and Uno that the capability would
7 have performed in a different mail processing system. Nothing in the record
8 suggests that modifying Sansone's mail processing system to add this
9 capability would have produced unpredictable or unexpected results.
10 Therefore, the combination would have been obvious.

11 Consider the situation when original transaction information
12 concerning mail bearing pre-printed postage values determined using the
13 first rate table is applied to the wrong customer's account. Further suppose
14 that the postage printed on this mail subsequently is corrected. We agree
15 with the Examiner (Ans. 17) that the transfer capability suggested by
16 Bernard would transfer the transaction information to the correct account by
17 performing the steps of deleting the record of the original transaction
18 information stored in connection with the incorrect customer's account;
19 generating new transaction information for the mail; and saving the new
20 transaction information in the correct customer's account. Combining
21 Bernard's teaching suggesting the performance of these steps with the
22 teachings of Sansone and Uno, the method recited in claim 1 would have
23 been obvious.

1 CONCLUSION

2 On the record before us, the Appellants have not shown that the
3 Examiner erred in rejecting claims 1-24 under § 103(a) as being
4 unpatentable over Sansone, Uno and Bernard.

5
6 DECISION

7 We AFFIRM the rejection of claims 1-23.

8 No time period for taking any subsequent action in connection with
9 this appeal may be extended under 37 C.F.R. § 1.136(a) (2007). *See* 37
10 C.F.R. § 1.136(a)(1)(iv) (2007).

11
12 AFFIRMED

13
14
15
16 hh

17
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